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Mitch Fredrick Singer

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PROCOPIO, CORY, HARGREAVES & SAVITCH LLP

530 B STREET

SUITE 2100

SAN DIEGO, CA 92101

EXAMINER

DUNN, DARRIN D

ART UNIT

PAPER NUMBER

2121

NOTIFICATION DATE

DELIVERY MODE

11/28/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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PTONotifications@procopio.com

Office Action Summary	Application No. 10/686,956	Applicant(s) SINGER ET AL.	
	Examiner DARRIN DUNN	Art Unit 2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/02/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the communication filed on 09/02/2008.
2. Claims 1-40 are pending in the application. Claim 40 has been withdrawn from consideration.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 32 recites the limitation "the device. There is insufficient antecedent basis for this limitation in the claim because a device may comprise a receiving device and/or a providing device.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1-18 are rejected under 35 U.S.C. 102(a) as being anticipated Messerges et al. (USPN 20020157002 A1).
7. As per claim 1, Messerges et al. teaches a method of presenting content data, comprising:

receiving at a client connected to a hub network a present request indicating locked content data ([0042], [0049] e.g., requested content, i.e., receiving at a client, a request for locked content data, i.e., encrypted content file);

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checking a license corresponding to said locked content data to determine if said license permits said client to present said locked content data ([0049], [0060-61] e.g., verifying the package's rights document , hash, and encoded rights table) ,

wherein said locked content data is a bound instance if said license permits presentation of said locked content data by said client connected to the hub network ([0060-63], [0037- 38], [0040], [Figure 4] e.g., all devices registered to a domain will be interconnected in that they will have access to content within the domain. Content is cryptographically bound to the domain ID), and

wherein the bound instance of said locked content data and the license corresponding to said locked content data are bound to the hub network ([0060-63], [0037-38], [0040], e.g., content is bound to the device domain); and

presenting said locked content data through a presentation component connected to said client when said locked content data is a bound instance ([0059-63], [Figure 3] e.g, before content may be played, the content manager invokes the core digital rights management software)

8. As per claim 2, Messerges et al. teaches the method of claim 1, wherein:

said locked content data and said license corresponding to said locked content data are stored on a hub network server ([0042-49] e.g., requested content is provided from a content provider. The requested content, as part of the content package, further includes an electronic rights table, a rights document, encrypted content....The objects of the content package may optionally be provided by two files – a license file, encoded rights table, and an encrypted content, etc)

9. As per claim 3, Messerges et al. teaches the method of claim 2, wherein:

presenting said locked content data includes decrypting said locked content data to produce

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output content data and sending said output content data to said presentation component ([0060-62])

10. As per claim 4, Messerges et al. teaches the method the method of claim 1, wherein: said locked content data is stored on a server ([Figure 2 –element 210], [Figure 4 -element 406] e.g., server, not defined, is interpreted as a source for content), wherein said server is connected to said client in said hub network ([Figure 2], [Figure 4])

11. As per claim 5, Messerges et al. teaches he method of claim 1, wherein: checking said license includes sending a confirm license request to said server from said client ([0060-61] e.g., a content package is opened via verifying the package's rights document, hash, and encoded rights table....)

12. As per claim 6, Messerges et al. teaches the method of claim 5, wherein: presenting said locked content data includes receiving output content data streamed from said server to said client ([0062] e.g., streaming content)

13. As per claim 7, Messerges et al. teaches the method of claim 5, further comprising: checking a revocation list to determine whether said client is included in said revocation list ([0073], [0029], [0063-64], e.g., revocation list may be provided via a web server application);

wherein said revocation list indicates devices for which the license has been revoked, and wherein said revocation list is stored on said server ([0073] e.g., this functionality may be provided via a web server)

14. As per claim 8, Messerges et al. teaches the method of claim 1, further comprising: checking a revocation list to determine whether said client is included in said revocation

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list ([0029], [0063-64]);

wherein said revocation list indicates devices for which the license has been revoked, and

wherein said revocation list is stored on said client ([0074], [Figure 11- element 1110])

15. As per claim 9, Messerges et al. teaches the method of claim 1, wherein: said locked content data is media data ([0031])

16. As per claim 10, Messerges et al. teaches the method of claim 1, wherein: said presentation component is integral to said client ([Figure 3- phones including a display])

17. As per claim 11, Messerges et al. teaches the method of claim 1, wherein: said presentation component is external to said client ([Figure 3- phones include an integrated, external display])

18. As per claim 12, Messerges et al. teaches the method of claim 1, wherein: said presentation component includes a television ([0003], [0040], [Figure 5- set-top box])

19. As per claim 13, Messerges et al. teaches the method of claim 1, wherein: said presentation component includes an audio speaker system ([0028], [Figure 5])

20. As per claim 14, Messerges et al. teaches a method of presenting content data, comprising:

receiving at a server connected to a hub network a present request indicating locked content data and indicating to a client connected to said hub network to present the content data ([0060-62]);

checking a license corresponding to said locked content data to determine if said license permits said server to present said locked content data through said client ([0060-61] e.g., verifying the package's rights document, hash, and encoded rights table),

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wherein said locked content data is a bound instance if said license permits presentation of said locked content data by said server through said client connected to a-the hub network ([0060-63], [0037- 38], [0040], [Figure 4] e.g., all devices registered to a domain will be interconnected in that they will have access to content within the domain. Content is cryptographically bound to the domain ID), and

wherein the bound instance of said locked content data and the license corresponding to said locked content data are bound to the hub network ([0060-63], [0037-38], [0040], e.g., content is bound to the device domain); and

presenting said locked content data through a presentation component connected to said client when said locked content data is a bound instance ([0059-63], [Figure 3] e.g, before content may be played, the content manager invokes the core digital rights management software)

21. As per claim 15, Messerges et al. teaches the method of claim 14, wherein:

streaming data to said client includes streaming locked content data to said client ([0062])

22. As per claim 16, Messerges et al. teaches the method of claim 14, further comprising:

decrypting said locked content data ([0060])

23. As per claim 17, Messerges et al. teaches the method of claim 14, wherein: said present

request is received from said client ([0042], [0060])

24. As per claim 18, Messerges et al. teaches the method of claim 14, further comprising:

checking a revocation list to determine whether said client is included in said revocation list ([0073], [0029], [0063-64], e.g., revocation list may be provided via a web server application);

wherein said revocation list indicates devices for which the license has been revoked, and

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wherein said revocation list is stored on said server ([0073] e.g., this functionality may be provided via a web server)

Claim Rejections - 35 USC § 103

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

27. Claims 19-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messerges et al. (USPN 20020157002 A1) in view over Russell et al. (20020069420)

28. As per claim 19, Messerges et al. teaches a method of copying content data, comprising:

receiving in a hub network a request indicating locked content data ([0031], [0045], [0053] e.g. users may wish to copy newly purchased content packages), ; and

copying said locked content data to produce a copy of said locked content data when said locked content data is a bound instance with a corresponding license that is bound to said hub network ([0062] e.g., streaming, copying, loaning, or moving content to other trusted devices);

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wherein the bound instance if said locked content data and the license corresponding to said locked content data are bound to the hub network ([0062-64] e.g., trusted devices are interpreted as belonging to the authorized domain)

However, Messerges et al. does not teach a copy request and copying said locked content data to produce a copy of said locked content data. Messerges teaches said locked content data is a bound instance with a corresponding license that is bound to said hub network ([0062] e.g., streaming, copying, loaning, or moving content to other trusted devices). Messerges teaches a request for locked content data from a content provider ([0042]) Russell et al. teaches a main server containing copy of each content item ([0074], [0080])

Therefore, at the time the invention was made, one of ordinary skill in the art would have motivation to include a server copy of protected content for distribution. Since it is foreseeable that users would request a replacement of content that may have been corrupted, it would be necessary to provide a copy of the original content to the user opposed to sending the original content. Russell et al. illustrates that copies of content are maintained, and therefore it would have been obvious to enable the user to receive a copy of requested content.

29. As per claim 20, Messerges, as modified, teaches the method of claim 19, further comprising:

checking said license to determine if said license permits said locked content data to be copied ([0007] e.g., users request copies, [0042], [0049] e.g., it is interpreted that in a digital rights management system that a user is verified prior to being provided digital content. As modified, a copy request would additionally include a verification of a user's permission)

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30. As per claim 21 Russell et al, as modified, teaches the method of claim 19, further comprising:

requesting a new license from a server for said copy of said locked content data ([0037] e.g., new license); wherein said server is in said hub network and connected to said client (e.g., Messerges, as modified, teaches providing content to a network such that content is bound to the network. A server providing such content via the network is understood as being in a hub network)

31. As per claim 22, Messerges et al. teaches the method of claim 19, further comprising:

sending said copy of said locked content data to a device that is not a member of said hub network ([0080] e.g., trusted devices outside the domain may be provided content if appropriate content protocol are supplied. As modified, it is interpreted that a content provider may provide copies to a device outside the authorized domain)

32. As per claim 23, Messerges et al. teaches the method of claim 19, further comprising:

sending said copy of said locked content data to a client that is a member of said hub network but is not connected to said hub network ([0038], [0040] e.g., a device may receive data bound to a network but may not be physically connected to the network or within range of the domain yet still be a registered member of the domain. For example, a host PC may provide remote download to a device outside of the domain range, i.e., connectivity.)

Therefore, it would have been obvious to provide a host PC to provide content a device outside the immediate domain because such content will not be rendered until the device becomes part of or connected to the authorized domain.

33. As per claim 24, Russell et al. teaches sending a new license to a client that is a member of said hub network but is not connected to said hub network ([0037] e.g., it is interpreted that a

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new license may be associated with a portable device. [0038], [0040] e.g., a device may receive data bound to a network but may not be physically connected to the network or within range of the domain yet still be a registered member of the domain. For example, a host PC may provide remote download to a device outside of the domain range, i.e., connectivity.)

Therefore, it would have been obvious to provide a host PC to provide content a device outside the immediate domain because such content will not be rendered until the device becomes part of or connected to the authorized domain.

34. As per claim 25, As per claim 8, Messerges et al. teaches the method of claim 1, further comprising:

checking a revocation list to determine whether said client is included in said revocation list ([0029], [0063-64]);

wherein said revocation list indicates devices for which the license has been revoked, and wherein said revocation list is stored on said client ([0074], [Figure 11- element 1110])

35. As per claim 26, Messerges et al., as modified, teaches a method of distributing content data, comprising:

receiving from a providing device connected to a hub network, and at a receiving device a copy of locked content data that is a bound instance bound to said hub network ([Figure 1], [Figure 5], ([0042], [0049] e.g., requested content, i.e., receiving at a client, a request for locked content data, i.e., encrypted content file)

requesting a new license for said copy of locked content data (e.g., as modified in view of Russell, new license requests and receiving copies could be part of a user request for content.

Please see Russell [0010], [0037], [0074]); and

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receiving said new license for said copy of locked content data of the bound instance bound to said hub network (e.g., Messerges teaches binding content to a network, which as modified with Russell, provides that copies of content and associated licenses are bound as well. Please see Messerges ([0060-63], [0037-38], [0040], e.g., content is bound to the device domain);

wherein the bound instance of said copy of locked content data and the new license corresponding to said copy of locked content data are bound to the hub network (e.g., Messerges teaches [0060-63], [0037-38], [0040], e.g., content is bound to the device domain);

36. As per claim 27, Russell et al. teaches the method of claim 26, wherein: said providing device is a client in said hub network ([0107] e.g., user may copy and store the copy on another computer)

37. As per claim 28, Messerges et al. teaches the method of claim 26, wherein: said providing device is a server in said hub network ([Figure 2- element 210, 216 (e.g., computer acting as a server in view of Russell)

38. Claims 29-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Messerges et al. (USPN 20020157002 A1) in view over Russell et al. (20020069420), and in further view of Peinado et al. (USPN 20030217011)

39. As per claim 29, Messerges et al., as modified, does not teach said new license is received from said client. Peinado et al. teaches a license store may be embodied in any other form so long as the license store performs the function of storing licenses in a location convenient for the DRM [0132])

Therefore, at the time the invention was made, one of ordinary skill in the art would have motivation to utilize a client as a license store. As a member of an authorized domain, the client

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is authorized to access protected content. Since several authorized clients are also present within the network, it would have been obvious to use a client as a convenient means of providing a license to another client computer.

40. As per claim 30, Russell et al., as modified, teaches the method of claim 26 wherein said new license is provided from a server in said hub network ([Figure 2- element 12])

41. As per claim 31, Russell et al., as modified, teaches the method of claim 26 wherein said new license is received from an external server that is not in said hub network ([Figure 2 - element 16])

42. As per claim 32, Messerges et al., as modified, teaches the method of claim 26, wherein said copy of locked content data has a corresponding license authority information stored on said device ([Figure 9], [0051], [0059], [0061], [0049] e.g., licensing authority, i.e., digital rights management software implements a content decoder to ask the content package manager to open a package. The content package is associated with a license)

said new license is received from a licensing authority indicated by said licensing authority information (e.g., Messerges et al., as modified by Russell et al, provides the ability to receive a new license. The licensing authority information, i.e., package rights, provides access to such content)

43. As per claim 33, Messerges et al, as modified, teaches the method of claim 26, wherein said receiving device is not a member of said hub network ([0053], [0054] e.g., users may still request content from a provider via a user interface; however, such users outside the domain may not be able to access such content until such devices are registered with the domain)

44. As per claim 34, Messerges et al., as modified, teaches the method of claim 26, wherein

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said receiving device is a member of a second hub network ([Figure 4 – elements 202₁ 202₂], [0040])

and said new license of said copy of locked content data is bound to said second hub network but not to said hub network ([Figure 4], [0040])

45. As per claim 35, Messerges et al. teaches the method of claim 26, wherein said receiving device is not connected to said hub network [0038], [0040] e.g., a device may receive data bound to a network but may not be physically connected to the network or within range of the domain yet still be a registered member of the domain. For example, a host PC may provide remote download to a device outside of the domain range, i.e., connectivity.)

Therefore, it would have been obvious to provide a host PC to provide content a device outside the immediate domain because such content will not be rendered until the device becomes part of or connected to the authorized domain.

46. As per claim 36, Messerges et al., as modified, teaches the method of claim 26, further comprising:

checking a revocation list to determine whether said receiving device is included in said revocation list ([0029], [0063-64]);

wherein said revocation list indicates devices for which the license has been revoked, and wherein said revocation list is stored on said receiving device ([0074], [Figure 11- element 1110])

47. As per claim 37, Messerges, as modified, teaches a method of distributing content data, comprising:

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receiving at a server connected to a hub network, and from a device a request for a new license for a copy of locked content data that is a bound instance bound to said hub network (e.g., Messerges, as modified by Russell, teaches binding content to a network where a user may request a new copy of content. The copy of the content would be bound to the network. See Messerges [0042-44]. See Russell [0037- providing copies], supra claim 19 discussion);

checking a root license stored on said server to determine if said root license permits said server to provide a new license for said copy of locked content data of the bound instance ([0042], [0049] content provider, i.e., root server. As modified, a user requesting a new license would be verified as to whether they are permitted access to content. Furthermore, permitting a license to be provided, as taught by Russell, would include checking for payment, i.e., permitting a license to be issued ([0106]) ; and creating said new license according to said root license ([0031], [0042] , [0059], [0061] e.g., providing associated rights and permission. Messerges in view of Russell teaches that users may acquire a new license, where a set usage rules is established. A request for a new license would include usage rule); sending said new license to said device ([0037 (e.g., Russell) teaches downloading a license, i.e., receiving a license), wherein said new license for said copy of locked content data of the bound instance is bound to said hub network ([0060-63], [0037- 38], [0040], [Figure 4] e.g., all devices registered to a domain will be interconnected in that they will have access to content within the domain. Content is cryptographically bound to the domain ID),

wherein the bound instance of said copy of locked content data and the new license are bound to the hub network ([0060-63], [0037-38], [0040], e.g., content is bound to the device domain. It is interpreted that content and associated license/usage rights are bound to the domain, in effect

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controlling who receives such content, i.e., registered with a domain, and how the content is rendered, i.e., set of usage rules - [0031])

48. As per claim 38, Messerges, as modified, teaches the method of claim 37, where said device is not connected to said hub network ([0038], [0040] e.g., a device may receive data bound to a network but may not be physically connected to the network or within range of the domain yet still be a registered member of the domain. For example, a host PC may provide remote download to a device outside of the domain range, i.e., connectivity.)

Therefore, it would have been obvious to provide a host PC to provide content a device outside the immediate domain because such content will not be rendered until the device becomes part of or connected to the authorized domain.

Response to Amendment

49. The amendment, filed 09/02/08, has been entered.

Response to Arguments

50. Applicant's arguments with respect to claims 1-38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

51. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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6920567

7010808

7020704

7203965(e.g., refer to eDan for relevant office actions)

7370364

20020019814

20020046181

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20030198351

20030076955 – Copying and moving content b/w domains

20030097564

20040003032

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20070143782(e.g., refer to eDan for relevant office actions)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DARRIN DUNN whose telephone number is (571)270-1645. The examiner can normally be reached on EST:M-R(8:00-5:00) 9/5/4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert DeCady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DD
11/21/08

/Albert DeCady/
Supervisory Patent Examiner
Art Unit 2121